

## REMARKS

### INTRODUCTION:

As set forth in the preceding section, no claims have been amended and claim 13 has been added. No new matter has been added by way of the new claim.

Claims 1, 5-7, 11 and 13 are pending and under consideration. Claims 1, 11 and 13 are independent claims. Reconsideration of the claims in view of the following remarks is respectfully requested.

### REJECTIONS UNDER 35 U.S.C. §103:

Claims 1, 5-7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "the applicant's admitted prior art" ("AAPA") in view of U.S. Patent No. 6,577,566 issued to Tomita ("Tomita") in view of U.S. Patent No. 6,731,573 Takeda ("Takeda"). Applicant traverses all of the rejections.

Previously amended claim 1 recites at least the following features:

generating a jump signal in response to a state of the land/groove signal varying;  
moving the optical pickup back by  $\frac{1}{2}$  of a track in response to the jump signal;

AAPA, Tomita and Takeda, taken separately or in combination, fail to suggest or disclose all of the above-recited features of previously amended independent claim 1.

The Office Action asserts at page 2 that AAPA describes all of the above-recited features. Applicant disagrees for at least the following reasons and respectfully requests reconsideration.

The Office Action cites paragraph 8, lines 1-5 of the present specification as describing the above-recited features of claim 1. The cited portion of the present specification states in full:

However, when an optical pickup of a disc drive playing a DVD-RAM disc with the above-described L/G structure is automatically paused, a number of times (FG) a spindle motor has rotated is counted or track identifications (lds) are read so as to move the optical pickup back by  $\frac{1}{2}$  of a track. However, when data is recorded in either land tracks or groove tracks, it is not useful to move the optical pickup back during inspection of a quality of a radio frequency (RF).

The above-cited paragraph does not mention or suggest generating a jump signal in response to a state of a land/groove signal varying, and moving the optical pickup back by ½ of a track in response to the jump signal. To the contrary, the cited paragraph clearly states that “a number of times (FG) a spindle motor has rotated is counted or track identifications (Ids) are read so as to move the optical pickup back by ½ of a track,” as claimed above.

The Office Action mailed February 19, 2008 additionally states:

On page 5 applicant argues that the applicant's admitted prior art fails to teach generating a jump signal in response to the land/groove signal varying. However, the examiner maintains this rejection because it is taught in paragraph 8 lines 1-5 generating a jump signal when the pickup is automatically paused. However, the jump signal could not be generated without the use of a L/G signal.

Accordingly, the rejection is based on the Office's assertion that “it is taught in paragraph 8, lines 1-5 generating a jump signal when the pickup is automatically paused” and the Office's assertion that “the jump signal count not be generated without the use of a L/G signal.”

In response, Applicant notes that neither of the Office assertions above forming the basis for the rejection is expressly described in paragraph 8 lines 1-5, as is readily apparent from the text above. It consequently appears that the Office is asserting that the features are inherent to the optical pickup described in paragraph 8, lines 1-5.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112 IV citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Applicant asserts that the current Office Actions fails to provide the objective evidence and technical reasoning necessary to support such a conclusion of inherency. If an assertion of inherency is to be relied upon in any future Office Action, Applicant respectfully requests the rejection provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied reference, as required by MPEP 2112 IV. Further, the Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

In addition, the Office Action fails to establish that either Tomita or Takeda describe the features.

Previously amended claim 1 further recites at least the following features:

determining from which track the tracking error signal has been generated using the generated land/groove signal, in response to the determination that the tracking error signal has been generated;

AAPA, Tomita and Takeda, taken separately or in combination, fail to suggest or disclose all of the above-recited features of previously amended independent claim 1.

The Office Action asserts at page 3 that Tomita describes all of the above-recited features at FIG. 14D and col. 29, lines 38-45. Applicant disagrees for at least the following reasons and respectfully requests reconsideration.

The Office Action mailed February 19, 2008 supports the above rejection, at page 5, based on the assertion that, in Tomita, the "land/groove signal is the polarity of the tracking error signal." Accordingly, the Office relies on the tracking error signal of Tomita to disclose both the tracking error signal and the land/groove signal recited above. Because the polarity of the tracking error signal of Tomita cannot be interpreted as a signal separate from the tracking error signal (i.e., the land/groove signal), Applicant asserts the rationale for the rejection is improper. MPEP 2111.01 requires that the words of the claim must be given their "plain meaning." Consequently, absent evidence to the contrary, the features "land/groove signal" and "tracking error signal" may only reasonably be interpreted as different signals, and not as identical signals as asserted in the Office Action.

Further, Takeda fails to compensate for the noted deficiencies of AAPA and Tomita.

Accordingly, Applicant respectfully submits that amended independent claim 1 patentably distinguishes over AAPA, Takeda and Tomita, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 11 and 13, with potentially differing scope and breadth, are not taught or disclosed by AAPA, Takeda and Tomita, the rejection should be withdrawn and claims 11 and 13 also allowed.

Regarding the rejection of claims 2 and 5-7, these claims depend directly or indirectly on independent claim 1, and are therefore believed to be allowable for at least the reasons noted above.

New claim 13 recites at least the following features:

generating a land/groove signal to discern land tracks and groove tracks of the DVD-RAM disc;

AAPA, Tomita and Takeda, taken separately or in combination, fail to suggest or disclose all of the above-recited features of claim 13.

The Office Action notes at page 3 that AAPA fails to describe the above-recited features. However, the Office Action proposes to modify AAPA based on Tomita and asserts that Tomita describes all of the above-recited features. Applicant disagrees for at least the following reasons and respectfully requests reconsideration.

Tomita is directed to a recording/playback apparatus used for recording and playing back data into and from a mini disc or a magneto optical disc in conformity with a format called MD-Data™. (col. 5, lines 19-23, emphasis added). In fact, a word search of Tomita reveals that Tomita fails to even mention a DVD-RAM disc as claimed above. Applicant notes that although Tomita makes a generalized statement that its description “can be applied to a disc adopting a phase change system used in a rewritable DVD,” Tomita still fails to specifically mention a DVD-RAM (col. 37, lines 28-35). Tomita, consequently, fails to suggest or disclose all of the above-recited features.

Further, Takeda fails to compensate for the noted deficiencies of AAPA and Tomita.

Accordingly, Applicant respectfully submits that independent claim 13 patentably distinguishes over AAPA, Takeda and Tomita, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 1 and 11, with potentially differing scope and breadth, are not taught or disclosed by AAPA, Takeda and Tomita, the rejection should be withdrawn and claim 1 and 11 also allowed. In addition, claims 5-7 which depend from independent claim 1 should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

#### CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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